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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/758,502 | 01/15/2004 | David Benderly | BENDERLY | 6160 |
| 156 | 7590 | 06/02/2006 | EXAMINER | |
| KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C. 489 FIFTH AVENUE NEW YORK, NY 10017 | | | HEINRICH, SAMUEL M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1725 | |

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/758,502 | Applicant(s) BENDERLY, DAVID | |
| | Examiner Samuel M. Heinrich | Art Unit 1725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

This application claims a priority date of July 20, 2009 which is incorrect.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38-43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a stencil filled with fusible coating material, does not reasonably provide enablement for the use of a "fusible material having a melting point greater than that of the gemstones". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the invention commensurate in scope with these claims. Hackh's Chemical Dictionary describes diamond as being unfusible, thereby having no melting point.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of EP0897021A1. Langan describes (column 1, lines 36-47) well known label

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manufacture and label shipping and subsequent label use at a site separate from the manufacture site. Langan does not describe applying stencils and subsequent marking objects. Yueh describe a well known stencil filled with fusible material such as metal. The use of a stencil such as disclosed by Yueh with a manufacture and shipping technique such as described by Langan would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the stencil can be produced at one site and used at a different site intended for a different production. EP0897021A1 describes (Basic-Abstract) the marking of gemstones with deposited material. The use of deposited material in a stencil at a manufacturing site would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the stencil provides reproducible markings.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of EP0897021A1 as applied to claim 38 above, and further in view of USPN 3,464,617 to Raynes et al. Raynes et al describe well known adhesive application of a perform carrier to a work piece. The use of such adhesive application would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the location of the coating material can be easily controlled.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of EP0897021A1 as applied to claim 38 above, and further in view of USPN 4,179,322 to Brown et al. Brown et al describes the use of a cover layer and the use thereof with a carrier a

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marking material would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the cover protects the work piece prior to the use thereof.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of EP0897021A1 as applied to claim 38 above, and further in view of Applicant's Admitted Prior Art (AAPA). AAPA describes (Specification, Description of the Related Art) related art which discloses well known application of marking material to diamonds including custom inscriptions and graphics. The use of a diamond workpiece with a marking process would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because marking of diamonds for identification has been done at least for decades.

Response to Arguments

Applicant's arguments with respect to new claims 38-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Samuel M Heinrich
Primary Examiner
Art Unit 1725

SMH